

REMARKS

I. Introduction

Claims 7, 10 and 12-13 are currently pending.

II. Drawings

In response to the Examiner's requirement that Applicant provide a drawing, a drawing sheet containing Fig. 1 is being submitted.

III. Rejection of Claims 7, 10 and 12-13 under 35 U.S.C. § 101

In response to the Examiner's comment that the process is not tied to a particular machine or apparatus, Applicant has amended independent claim 7 to explicitly tie the claimed method to the vehicle navigation system by reciting "operating the vehicle navigation system using the enabled useful data for the area defined by the user."

Accordingly, claim 7 and its dependent claims 10 and 12-13 define statutory subject matter.

IV. Rejections of Claims 7, 10 and 12-13 under 35 U.S.C. § 103(a)

Claims 7, 10 and 12-13 were rejected under 35 U.S.C. § 103(a) as being unpatentable over German Patent Document No. DE 101 55 485 ("Barkowski") in view of U.S. Patent No. 5,067,081 ("Person"). Applicant respectfully submits that the rejection should be withdrawn for at least the following reasons.

In rejecting a claim under 35 U.S.C. § 103(a), the Examiner bears the initial burden of presenting a *prima facie* case of obviousness. In re Rijckaert, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish a *prima facie* case of obviousness, the Examiner must show, *inter alia*, that there is some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify or combine the references, and that, when so modified or combined, the prior art teaches or suggests all of the claim limitations. M.P.E.P. §2143. In addition, as clearly indicated by the Supreme Court, it is "important to identify a reason that would have prompted a person of ordinary skill in the relevant field to [modify] the [prior art] elements" in the manner claimed. See KSR Int'l Co. v. Teleflex, Inc., 82 U.S.P.Q.2d 1385 (2007). In this regard, the Supreme Court further noted that "rejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." Id., at 1396.

To the extent that the Examiner may be relying on the doctrine of inherent disclosure in support of the obviousness rejection, the Examiner must provide a “basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics necessarily flow from the teachings of the applied art.” (See M.P.E.P. § 2112; emphasis in original; see also Ex parte Levy, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990)).

In support of the obviousness rejection of independent claim 7, the Examiner reiterates the view that “Person discloses . . . enabling the useful data for an area defined by the user by defining a center point and a radius of a circular region.” However, the Person reference merely discloses restricting the display area of a navigation display to a radius selected by the user, which is clearly different from the claimed limitation of “enabling the useful data for an area . . . defined by the user by defining a center point and a radius of circular region,” as recited in claim 7. To the extent the Examiner is implicitly contending that the disclosure of Person regarding the restriction of the display area of a navigation display inherently teaches or suggests the claimed limitation of “enabling the useful data for an area,” this implicit contention is unsupported since there is no “basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics necessarily flow from the teachings of the applied art.” In addition, the Examiner acknowledges that Barkowski does not suggest the above-recited limitation of claim 7. Accordingly, claim 7 and its dependent claims 10, 12 and 13 are allowable over the applied combination of references.

Independent of the above, to the extent the Examiner contends that the features of claim 10 regarding “the enabling of the useful data includes granting of a use authorization for the area defined by the user by defining the center point and the radius of the circular region” would be obvious based on the overall teachings of Barkowski and Person, i.e., “obvious . . . to modify Barkowski to define the area by center point and radius . . . in order to authorize an area most likely to be used,” this contention is not supported by the actual disclosure of the applied references. In this regard, Barkowski merely discusses a preferred access authorization code applied for a fixed geographical block or multiple blocks. (See Barkowski, Paragraph [0017]). Given this intended operation of the system in Barkowski, the modification asserted by the Examiner would fundamentally change the principle of operation of the device in Barkowski and/or render the device unsuitable for its original

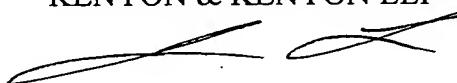
purpose, thereby negating the obviousness conclusion. (See MPEP 2143.01V, citing In re Gordon, 733 F.2d 900 (Fed. Cir. 1984); MPEP 2143.01VI, citing In re Ratti, 270 F.2d 810 (CCPA 1959)). In any case, Person does not suggest the feature of granting a use authorization for a specified area; instead, Person merely discloses restricting the display area of a navigation display to a radius selected by the user. Accordingly, there is no reasonable basis to conclude that the overall teachings of Barkowski and Person would suggest the features of amended claim 10. Accordingly, claim 10 is allowable over the applied combinations of references for this additional reason.

CONCLUSION

It is respectfully submitted that all pending claims of the present application are in allowable condition. Prompt reconsideration and allowance of the application are respectfully requested.

Respectfully Submitted,

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